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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/656,055

09/05/2003

Debbie Yaver

10322.200-US

8946

25907 7590
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1445 DREW AVE
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11/14/2008

EXAMINER

HINES, JANA A

ART UNIT

PAPER NUMBER

1645

NOTIFICATION DATE

DELIVERY MODE

11/14/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Patents-US-CA@novozymes.com

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	<p>Application No. 10/656,055</p>	<p>Applicant(s) YAYER ET AL.</p>	
	<p>Examiner JaNa Hines</p>	<p>Art Unit 1645</p>	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 October 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 22 October 2008. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: None.
Claim(s) objected to: None.
Claim(s) rejected: 1, 11, 36, 42, 43, 82-88 and 90-93.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Page.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Mark Navarro/
Primary Examiner, Art Unit 1645

Applicants' argue that a prima facie case has not been established. However, it is the Office's position that it would have been prima facie obvious at the time of applicants' invention to apply the *Bacillus subtilis* strain of Cao et al., to Wilson et al., method for determining the mode of action of an antimicrobial compound in order to provide obtain antimicrobial mode of action results for *B. subtilis* which is known to be resistant to known antimicrobial drugs. Furthermore, one of ordinary skill in the art would have a reasonable expectation of success by exchanging one gram-positive bacterium for another gram-positive bacteria because both bacteria are known in the art to have analyzed on DNA microarrays wherein the hybridization complexes detected in the presence of subinhibitory amounts of antimicrobial compounds.

Applicants' assert that the claimed method produces unexpected results by using subinhibitory amounts. However, no more than routine skill is involved in adjusting the concentration of the claimed process to suit a particular starting material in order to achieve the same results taught in the prior art. Using subinhibitory amounts is not beyond the skill of one of ordinary skill in the art and the resulting invention would have been obvious because a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. Especially if it leads to the anticipated success, it is therefore likely to be product not of innovation but of ordinary skill and common sense. Objective evidence which must be factually supported by an appropriate affidavit or declaration to be of probative value includes evidence of unexpected results. It is well settled that unexpected results must be established by factual evidence. Applicants have not presented any experimental data, therefore applicants assertions of unexpected results constitute mere argument.

Applicants' urge that there is no suggestion to combine the references, however all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. Furthermore, the provide motivation because it would have been obvious to combine the invention of Wilson et al., and Cao et al., to advantageously achieve a determining drug-induced alterations in gene expression by microarray hybridization for multi-drug resistant bacteria. Therefore applicants arguments are not persuasive and the rejection is maintained.